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09/414,547	10/08/1999	TOKIMORI TOMITA	122.1046-D/G	3462

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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01/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/414,547

Applicant(s)

TOMITA ET AL.

Examiner

STEFANOS KARMIS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 97, 98 and 100 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 97, 98, 100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

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DETAILED ACTION

1. The following communication is in response to Applicant's amendment filed 25 October 2007.

Status of Claims

2. Claims 97, 98 and 100 are currently amended. Claims 1-96 and 99 are cancelled.

Therefore claims 97, 98 and 100 are currently pending.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 97, 98 and 100 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 10 and 12 of U.S. Patent No. 6,965,869.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to calculate the amount of points using a calculation rate when issuing points. Furthermore, it would be obvious to one of ordinary skill in the art that points issued based on customer transactions could be based on the purchase amount. For these reasons the claims of the pending applications are not patentably distinct from U.S. Patent No. 6,965,869.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 97, 98 and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz et al. (hereinafter Schultz) U.S. Patent 5,056,019 in view of Deaton et al. (hereinafter Deaton) U.S. Patent 5,201,010 in further view of Nichtberger et al. (hereinafter Nichtberger) U.S. Patent 4,882,675.

Regarding claims 97, 98 and 100, Schultz teaches a method for managing points issued according to transactions under identification of a customer in a system connected to a terminal via a communication link, comprising;

Identifying said customer according to customer identification information obtained from said terminal (column 9, lines 25-38 and lines 66 thru column 10, line 6; Examiner notes that the

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customer is identified by using their bar-coded identification code to be scanned by the in-store computer);

Issuing points according to said transactions under said identification (column 6, lines 5-27; Examiner notes that the manufacturer awards the consumer with points for each purchase of a particular products and that a gift is earned when a particular number of points is attained by the customer);

Managing said points of said customer by calculating a balance point of said customer according to transactions performed by said customer (column 6, lines 5-12; Examiner notes that the manufacturer awards the consumer with points for each purchase of a particular products and that a gift is earned when a particular number of points is attained by the customer and column 10, lines 20-28; Examiner notes that the central management system determines the consumer's earned rewards, page 10, paragraph 20-28);

Schultz further teaches that the in-store computer comprises a databank for storing a plurality of files including customer files containing information related to consumers participating in frequent shopper program and reward files containing information related to the purchase reward offers (column 9, lines 47-53).

Schultz teaches sending point balance to customer via a status report that comes in the mail, the status report containing information about reward amounts and different types of reward certificates, such as negotiable check, or a voucher to be redeemed at a participating store for cash or credit towards product purchases (column 8, lines 48-67).

Schultz fails to teach that the point balance is sent to the terminal after the customer identification.

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Deaton teaches dissemination of Point-Of-Sale coupons that are earned based on previous transactions and shopping history of the customer (column 67, lines 56 thru column 68, line 12; Examiner notes that the coupons are analogous to the reward certificates taught in Schultz). Deaton teaches using a checking account ID to identify the customer at the point of sale (column 68, lines 13-67, see steps 6-13). Deaton further teaches that the coupon reward and other incentives are made at the point of sale terminal and applied to the current purchase (column 69, lines 46 thru column 70, line 46).

Nichtberger teaches a paperless system for distributing, redeeming and clearing merchandise coupons in which a customer presents his special card before the checkout process begins and the in-store computer unit receives the customer's coupons from the CDR and applies the coupons to items as they are being purchased before totaling the purchase amount (column 17, lines 30-61).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Schultz to include having the customer access their reward coupons as items are being purchased (before the purchase total) as taught by Deaton and Nichtberger because it allows the customer to take advantage of earned coupons/rewards through their shopping history (previous transactions) at the point of sale when items are being purchased rather than having to make another trip back to the store or having to remember to bring the physical coupon/reward. There is sufficient motivation combine the teachings of Schultz with Deaton and Nichtberger because the reward certificates taught by Schultz act as earned coupons that can be applied for a discount or free gift. Schultz teaches that

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the reward certificate can be a voucher to be redeemed at the store for credit towards product purchases and is therefore applied similarly to the coupons taught by Deaton and Nichtberger.

Response to Arguments

7. Applicant's arguments with respect to claims 97, 98 and 100 have been considered but are moot in view of the new ground(s) of rejection. Examiner asserts that Deaton makes up for any lack of teachings of Schultz in view of Nichtberger, because Deaton teaches reward coupons earned through previous purchases, which are redeemable at the point of sale. The ability to see all earned reward coupons, allows the consumer to see the balance of his earned rewards.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEFANOS KARMIS whose telephone number is (571)272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted

Stefanos Karmis

22 January 2008

A handwritten signature in black ink, appearing to read 'Stefanos Karmis', written over the typed name.